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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/550,817

09/23/2005

Stefan Jatzke

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EXAMINER

SMALLEY, JAMES N

ART UNIT

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3781

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/550,817	Applicant(s) JATZKE ET AL.	
	Examiner JAMES N. SMALLEY	Art Unit 3781	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. Due to the new grounds of rejection, the previous indication of allowable subject matter is withdrawn, and a new grounds of rejection is presented below. Accordingly, this Action is **Non-Final**.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4-8, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morel US 4,290,536 in view of Schmitz et al. US 4,588,105.

Regarding claims 1 and 8, Morel '536 teaches a central closure section formed as a hollow cylindrical shape (2) with a closed end (5), and an open end (unlabeled), an engaging section (8) having a surrounding sealing lip (9), and a further sealing lip (10).

The structures taught by Morel '536 are capable of forming a latching connection with a hole in a vehicle body, before the softer plastic is melted to form the connection shown in figure 3. Examiner notes the claim preamble limits the scope to the plug apparatus, with the intended use of sealing a hole in a vehicle body. Because the combination is not claimed, the prior art must only teach the claimed physical structures, and be capable of being used in the intended manner.

The reference teaches forming the fusible ring of plastic, but fails to teach if the plastic is softer than the plastic main body.

Schmitz '105 teaches forming a hot melt ring (3) in a sealing plug of plastic. Furthermore, Examiner notes in figures 2 and 4-10, the cross-hatching of the seal is consistent with "foam-synthetic resin" per the Drawing Symbols found in MPEP 608.02. Thus, because Morel '536 teaches plastic

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forming the base of the plug, while Schmitz '105 is teaching a hot-melt foam plastic, the resultant engaging section would likely be softer than the central closure section.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the plug of Morel '536, forming the melting material of plastic, as taught by Schmitz '105, motivated by the benefit of providing easily molded inexpensive sealing means. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Moreover, Examiner notes The Supreme Court in *KSR* reaffirmed the familiar framework for determining obviousness as set forth in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)), but stated that the Federal Circuit had erred by applying the teaching- suggestion-motivation (TSM) test in an overly rigid and formalistic way. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1391. Specifically, the Supreme Court stated that the Federal Circuit had erred in four ways: (1) "by holding that courts and patent examiners should look only to the problem the patentee was trying to solve " (*Id.* at ___, 82 USPQ2d at 1397); (2) by assuming "that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem" (*Id.*); (3) by concluding "that a patent claim cannot be proved obvious merely by showing that the combination of elements was obvious to try" (*Id.*); and (4) by overemphasizing "the risk of courts and patent examiners falling prey to hindsight bias" and as a result applying "[r]igid preventative rules that deny factfinders recourse to common sense" (*Id.*). In *KSR*, the Supreme Court particularly emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *Id.* at ___, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at ___, 82 USPQ2d at 1395.

Furthermore, the Supreme Court issued rationales which support the conclusion of obviousness, and which can be found in the MPEP 2141(III). Under rationale (B), it is obvious to substitute one known element for another, with predictable results. However, one of ordinary skill in the art would not find it

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obvious to literally substitute the ring of Schmitz '105 onto the central closure section/plug of Morel '536. Instead, the question is not whether the prior art devices can be physically combined, but whether a person of ordinary skill in the art would have found it obvious to combine different features or elements of known devices in a predictable way. See *Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 1013 (Fed. Cir. 1983): "There is a distinction between trying to physically combine the two separate apparatus disclosed in two prior art references on the one hand, and on the other hand trying to learn enough from the disclosures of the two references to render obvious the claims in suit. ...Claims may be obvious in view of a combination of references, even if the features of one reference cannot be substituted physically into the structure of the other reference."

Regarding claims 2 and 7, Morel '536 fails to explicitly teach an interlock.

Schmitz '305, in the embodiments of figures 4-10, teach various interlocks between a hot melt seal and a plug.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the central closure section and engaging sections of Morel '536, forming them to interlock, as taught by Schmitz '305, motivated by a more secure connection to further prevent separation of the two elements.

Again, regarding the physical combination, the question is not whether the prior art devices can be physically combined, but whether a person of ordinary skill in the art would have found it obvious to combine different features or elements of known devices in a predictable way. See *Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 1013 (Fed. Cir. 1983): "There is a distinction between trying to physically combine the two separate apparatus disclosed in two prior art references on the one hand, and on the other hand trying to learn enough from the disclosures of the two references to render obvious the claims in suit. ...Claims may be obvious in view of a combination of references, even if the features of one reference cannot be substituted physically into the structure of the other reference."

Thus, specifically regarding claim 7, the embodiment of figure 4 teaches a surrounding recess (10, 11).

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Regarding claim 4, Schmitz '305 teaches the plastic seal melts between 85 and 180 degrees Celsius, which partially overlaps the claimed range.

Regarding claim 5, Examiner notes the flap (7) and projection (4) of Morel '536 will inherently provide resilient force on the engaging section, when applied to a hole.

Regarding claim 6, the closure section (1) has a hollow cylindrical shape about wall (2), and bends outward at (1, 6).

Regarding claim 11, Examiner notes the deepening (formed by 6 and 2, in figure 1) comprises a U-shaped cross-section.

Regarding claim 13, the engaging section (8) is inserted in the deepening, as clearly shown in figures 1 and 2.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morel US 4,290,536 in view of Schmitz et al. US 4,588,105 as applied above to claim 1, in view of Morris, Sr. et al. US 6,170,691.

Morel '536, as applied, teaches all limitations substantially as claimed, but fails to teach the two sections being glued together.

Morris '691, in the embodiment of figure 18, teaches a closure for a container, comprising two sections (29, 41) which are connected, and discloses in column 8, lines 2-6, the equivalence of snap-fit, pressure fit, welding/bonding, and adhesives.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the closure of Morel '536, connecting the closure section and the engaging section with an adhesive/gluing, as taught to be a known equivalent connection means for bonding or snap-fit, by Morris '691, motivated by the benefit of a more secure connection between the two elements.

The Supreme Court in *KSR* reaffirmed the familiar framework for determining obviousness as set forth in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)), but stated that the Federal Circuit had erred by applying the teaching- suggestion-motivation (TSM) test in an overly rigid and formalistic way. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1391. Specifically, the Supreme Court stated that the Federal

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Circuit had erred in four ways: (1) “by holding that courts and patent examiners should look only to the problem the patentee was trying to solve ” (*Id.* at ___, 82 USPQ2d at 1397); (2) by assuming “that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem” (*Id.*); (3) by concluding “that a patent claim cannot be proved obvious merely by showing that the combination of elements was obvious to try” (*Id.*); and (4) by overemphasizing “the risk of courts and patent examiners falling prey to hindsight bias” and as a result applying “[r]igid preventative rules that deny factfinders recourse to common sense” (*Id.*). In *KSR*, the Supreme Court particularly emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *Id.* at ___, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at ___, 82 USPQ2d at 1395.

Furthermore, the Supreme Court issued rationales which support the conclusion of obviousness, and which can be found in the MPEP 2141(III). Under rationale (D), it is obvious to apply a known technique to a known device for predictable results.

Regarding the analogousness of the two references, Examiner notes both are closures, and both are formed of subcomponents which are joined together. Thus, one of ordinary skill in the art would have found it obvious to combine teachings from the two references.

Response to Arguments

5. Applicant's previous arguments with respect to claims 1-8 and 11-13 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES N. SMALLEY whose telephone number is (571)272-4547. The examiner can normally be reached on Monday - Friday 10 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571) 272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James N Smalley/
Examiner, Art Unit 3781

/Nathan J. Newhouse/
Supervisory Patent Examiner, Art Unit 3782